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09/813,702	03/21/2001	Daniel J. DeFabio JR.	33900-DIV1	6209

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EXAMINER
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FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/813,702

Applicant(s)

DEFABIO, DANIEL J.

Examiner

Jared J. Fureman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of the amendment, filed on 9/30/2003, which has been entered in the file. Claims 1, 3, 5-8, and 10-12 are pending.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schireck (US 5,306,049, cited by applicants) in view of Wahlberg (US 3,798,603, previously cited) and Nama (US 4,991,008).

Schireck teaches a memorabilia kit (10) comprising: an article (card 14) bearing an original signature (28) of a selected individual (in this example, a sports figure), wherein the article includes a unique identifier (a serial number, see figure 1) (see figure 1 and column 2 line 5 - column 3 line 5).

Schireck fails to specifically teach a real time video image of the individual signing the article.

Wahlberg teaches a system comprising: an image (generated via camera 537) of a selected individual (a purchaser) signing an article (tape 534), wherein the image is a real time image (in that the image is taken in real time) (see figures 2, 4, column 4 line 62 - column 5 line 21, column 5 lines 46-59, column 6 lines 8-13, column 9 lines 30-42,

column 10 line 65 - column 11 line 5, column 12 lines 35 - 54, and column 14 lines 4-13).

In view of Wahlberg's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck, a real time video image of the individual signing the article, in order to provide an individual with visual evidence of the authenticity of the signature and the individual.

Schireck as modified by Wahlberg fails to specifically teach the image being stored on a storage medium, the image comprising a plurality of successive frames, the medium being separate from the article, each frame including selected subsets of frames corresponding to the signing of the article, wherein at least one frame is encoded with the unique identifier corresponding to the article captured in the subset of frames.

Nama teaches a system for recording a transaction, including a real time video image (provided by camera 123) of an individual performing a transaction, which naturally includes the signing of an article (such as a check or credit card receipt), the image is stored on a storage medium (by video recorder 134), and the image is comprised of a plurality of successive frames, frames including selected subsets of frames corresponding to the signing of the article (frames will include the signing of an article such as a check or credit card receipt), wherein at least one frame is encoded with the unique identifier corresponding to the article captured in the subset of frames (transaction data is stored with the video images) (see figure 3, column 3 lines 42-59, column 8 line 23 - column 9 line 42, and column 11 line 63 - column 12 line 2).

In view of Nama's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck as modified by Wahlberg, the image being stored on a storage medium, and the image comprising a plurality of successive frames, the medium being separate from the article, each frame including selected subsets of frames corresponding to the signing of the article, wherein at least one frame is encoded with the unique identifier corresponding to the article captured in the subset of frames, in order to provide a record of individuals and transactions, which can be saved for verification at a later time.

3. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schireck as modified by Wahlberg and Nama in view of Schlauch (US 6,082,774).

The teachings of Schireck as modified by Wahlberg and Nama have been discussed above.

Schireck as modified by Wahlberg and Nama fails to teach the storage medium further including an additional recording of the individual involved in an event other than signing of the article, the storage medium further including statistical data indicative of accomplishments of the individual.

Schlauch teaches an article (100) bearing an original signature (130) of a selected individual (a preferred personality) and a recording (image 193) of the individual involved in an event (in this example, a baseball game) other than signing of the article, the storage medium further including statistical data (recorded on reverse side 102 of article 100) indicative of accomplishments of the individual (see figures 1A, 1B and column 17 lines 10-18).

In view of Schlauch's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck as modified by Wahlberg and Nama, the storage medium further including an additional recording of the individual involved in an event other than signing of the article, the storage medium further including statistical data indicative of accomplishments of the individual, in order to provide additional details of the individual, thereby increasing interest in the article.

4. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schireck as modified by Wahlberg and Nama in view of Ippolito (US 5,356,136).

The teachings of Schireck as modified by Wahlberg and Nama have been discussed above.

Schireck as modified by Wahlberg and Nama fails to teach a writing utensil, wherein the writing utensil is used in the signing of the signed article.

Ippolito teaches a memorabilia kit including an article (2) to be signed by a desired individual (for example, an athlete), a writing utensil (1), wherein the writing utensil is used in the signing of the article (see figure 1 and column 2 lines 15-35).

In view of Ippolito's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck as modified by Wahlberg and Nama, a writing utensil, wherein the writing utensil is used in the signing of the signed article, in order to allow the signing pen and article to be stored together.

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5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schireck as modified by Wahlberg and Nama in view of Erdelyi (US 6,631,522 B1).

The teachings of Schireck as modified by Wahlberg and Nama have been discussed above.

Schireck as modified by Wahlberg and Nama fails to specifically teach the video image being stored on a compact disc.

Erdelyi teaches that video images may be stored on video tapes, compact discs, etc. (see column 13 lines 41-47).

In view of Erdelyi's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck as modified by Wahlberg and Nama, the video image being stored on a compact disc, since compact discs are not subject to wear and image degradation as are video tapes, thereby providing a longer lasting, more durable storage medium.

Schireck as modified by Wahlberg, Nama, and Erdelyi fails to specifically teach the article being a compact disc.

However, at the time of the invention it was well known to have a compact disc signed or autographed by an individual (such as a singer or musician).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Schireck as modified by Wahlberg, Nama, and Erdelyi, the article being a compact disc, in order to provide memorabilia from a singer or musician.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 3, 5-8, and 10-12 have been considered but are moot in view of the new ground(s) of rejection.

Note that a different interpretation of the Schireck patent is now being applied, namely the interpretation of card 14 as a signed "article", rather than item 12. Also, the newly applied references to Nama and Erdelyi teach a real time video image comprised of a plurality of successive frames stored on a storage medium, and storing a video image on a compact disc, respectively.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vonfeldt et al (US 2003/0191694 A1), McWilliam et al (US 2003/0198365 A1), Lucarelli et al (US 2003/0220885 A1), Davis, Jr et al (US 2003/0130912 A1), and JP 2003-141473 A all teach systems and methods for authenticating memorabilia.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424 (effective January 15, 2004, the telephone number will be (571) 292-2391). The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

December 18, 2003

*Jared J. Fureman*  
Jared J. Fureman  
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